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09/746,684	12/22/2000	Sridhar Iyengar	42390P10467	1658

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EXAMINER

GOLD, AVI M

ART UNIT PAPER NUMBER

2157

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/746,684

Applicant(s)

IYENGAR ET AL.

Examiner

Avi Gold

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This action is responsive to the application filed December 22, 2000. Claims 1-22 are pending. Claims 1-22 represent formatting and delivering arbitrary content to wireless handheld devices.

### *Specification*

A summary of the invention was not found in the specification. The examiner requests that one is added.

### Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

Art Unit: 2157

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the

field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

### ***Claim Objections***

1. Claim 10 objected to because of the following informalities: It should say "The method of claim 1" instead of "The method If claim 1". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2, 6-11, and 14-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawkins et al., U.S. Patent No. 6,343,318.

Hawkins teaches the invention as claimed including low bandwidth network access to Internet based information (see abstract).

Regarding claim 1, a method for a handheld device to facilitate interaction with a viewing device receiving a broadcast, comprising:

indicating with the handheld device interest in obtaining a content catalog identifying content in a first data format provided by a content provider (col. 3, lines 32-48; Hawkins discloses predefined applications and data formatted according to a first markup language);

receiving the content catalog from a formatting agent (col. 3, lines 32-48; Hawkins discloses a client receiving content from a server);

selecting content in the content catalog having the first data format (col. 3, lines 32-48; Hawkins discloses a client generating queries); and

receiving said selected content from the formatting agent in a second data format compatible with the handheld device (col. 3, lines 32-48; Hawkins discloses responses formatted to a second markup language).

Regarding claim 2, the method of claim 1, wherein the handheld device comprises a wireless coupling to the formatting agent (col. 3, lines 49-52; Hawkins discloses a handheld computer with wireless communication between the client and server).

Regarding claim 6, the method of claim 1, wherein the first data format is incompatible with the handheld device, the method further comprising:

retrieving said selected content from the content provider (col. 3, lines 32-48);  
converting the first data format into the second data format (col. 3, lines 32-48);  
transmitting the second data format to the handheld device (col. 10, lines 1-17;  
Hawkins discloses converted content sent to a handheld device); and  
rendering the second data format on the handheld device (col. 20, lines 13-27;  
Hawkins discloses content rendered on the wireless client).

Regarding claim 7, the method of claim 1, further comprising:  
retrieving by the formatting agent of said selected content from the content provider (col. 3, lines 32-48);  
determining the first data format is incompatible with the handheld device (col. 3, lines 32-48); and  
converting said selected content into said compatible second data format (col. 3, lines 32-48; col. 10, lines 1-17).

Regarding claim 8, the method of claim 7, wherein said converting comprises:  
determining characteristics of the handheld device (col. 10, lines 1-17; Hawkins discloses appropriate size and bit depth for display in a wireless communication device);  
identifying a portion of said selected content that is incompatible with the handheld device (col. 10, lines 1-17; Hawkins discloses size and bit depth that need to be converted); and  
converting said incompatible portion into a compatible portion based on said determined characteristics (col. 10, lines 1-17; Hawkins discloses converting image contents).

Regarding claim 9, the method of claim 7, wherein said incompatible portion comprises an Internet communication protocol (col. 10, lines 1-17; Hawkins discloses conversion of Internet protocols and content into a form that can be used by the wireless communication device).

Regarding claim 10, the method of claim 1, wherein the content catalog comprises selected ones of: links to content provider content, and embedded content provider content (col. 6, lines 33-47; Hawkins discloses various types of content).

Regarding claim 19, the system of claim 18, wherein the first data format is the same as the second format (col. 9; lines 29-51; Hawkins discloses the use of CML at both locations).



Regarding claim 20, the system of claim 18, wherein said second instructions include further instructions for converting the first data format into the second data format (col. 3, lines 32-48; col. 10, lines 1-17).

Regarding claim 21, The system of claim 18, further comprising:  
a content provider communicatively coupled to the formatting server (col. 3, lines 32-48);

wherein said first instructions include further instructions, which when executed by the handheld device, direct the handheld device to retrieve content from the content provider (col. 3, lines 32-48).

Regarding claim 22, the system of claim 21, wherein said instructions include further instructions, which when executed by the handheld device, direct the handheld device to:

display the catalog on the handheld device (col. 3, lines 32-48);  
receive a selection of a catalog entry corresponding to content provided by a content provider (col. 3, lines 32-48); and  
retrieve said content from the content provider (col. 3, lines 32-48).

Claims 11, 14-18 do not teach or define any new limitations above claims 1 and 6-8 and therefore are rejected for similar reasons.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-5, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins further in view of Dunn et al., U.S. Patent No. 6,154,772.

Hawkins teaches the invention substantially as claimed including low bandwidth network access to Internet based information (see abstract).

As to claim 3, Hawkins teaches the method of claim 1.

Hawkins fails to teach the limitation further including the content catalog content corresponding at least in part to broadcasts available for receipt by the viewing device.

However, Dunn teaches a system and method for the delivery of digital video and data over a communication channel (see abstract). Dunn teaches the use of content available in broadcasts (col. 18, lines 4-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hawkins in view of Dunn to use the content catalog content corresponding at least in part to broadcasts available for receipt by the viewing device. One would be motivated to do so because broadcasted content is easily transferred.

As to claim 4, Hawkins teaches the method of claim 1.

Hawkins fails to teach the limitation further including broadcasting the broadcast to the viewing device over a communication channel; determining broadcast-related data for the broadcast; and making said broadcast-related data available to a content initiator so that the content initiator associates said broadcast related data with the content catalog.

However, Dunn teaches a system and method for the delivery of digital video and data over a communication channel (see abstract). Dunn teaches the use of a communication channel for broadcasting content and available digital video content (col. 18, lines 4-49).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hawkins in view of Dunn to broadcast the broadcast to the viewing device over a communication channel; determining broadcast-related data for the broadcast; and making said broadcast-related data available to a content initiator so that the content initiator associates said broadcast related data with the content catalog. One would be motivated to do so because it allows the broadcasted content to be sent to the viewing device and the content catalog to have information regarding said broadcasted content.

As to claim 5, Hawkins and Dunn teach the method of claim 4.

Hawkins fails to teach the limitation further including the providing, by a broadcaster, said broadcast-related data to a content provider so that the content provider makes said broadcast-related data available to the content initiator.

However, Dunn teaches a system and method for the delivery of digital video and data over a communication channel (see abstract). Dunn teaches the use of hundreds of channels on a broadcast backplane (col. 18, lines 4-89).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hawkins in view of Dunn to provide broadcast-related data to a content provider so that the content provider makes said broadcast-related data available to the content initiator. One would be motivated to do so because it allows the user to choose from content that is broadcasted.

Claims 12 and 13 do not teach or define any new limitations above claims 4 and 5 and therefore are rejected for similar reasons.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. No. 6,574,660 to Pashupathy et al.

U.S. Pat. No. 6,317,795 to Malkin et al.

U.S. Pat. No. 6,259,405 to Stewart et al.

U.S. Pat. No. 6,671,715 to Langseth et al.

U.S. Pat. No. 6,166,778 to Yamamoto et al.

U.S. Pat. No. 6,567,660 to Wegener et al.

U.S. Pat. No. 6,088,455 to Logan et al.

U.S. Pat. No. 6,412,112 to Barrett et al.

U.S. Pat. No. 6,587,835 to Treyz et al.

U.S. Pat. No. 6,457,047 to Chandra et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Avi Gold whose telephone number is 703-305-8762. The examiner can normally be reached on M-F 8:00-5:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Avi Gold

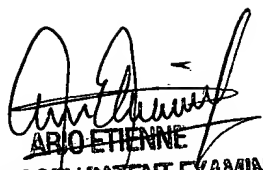
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Patent Examiner

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AMG



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